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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/087,403	02/28/2002	Susan Kay Cleveland	700.401	5338

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The Law Office of Debra J. Fickler
12525 Grandview Drive
Huntley, IL 60142-9501

EXAMINER

ASHLEY, BOYER DOLINGER

ART UNIT	PAPER NUMBER
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3724

DATE MAILED: 06/30/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/087,403

Applicant(s)

CLEVELAND ET AL.

Examiner

Boyer D. Ashley

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 April 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

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DETAILED ACTION

1. This office action is in response to applicant's amendment filed 4/5/04, wherein claims 1-7 were amended.

Claim Objections

2. Claims 7 and 19 are objected to because of the following informalities:

In claim 7, the phrase "method of claim 1 removing includes leaving..." is confusing, in that, it is awkwardly worded;

In claim 19, the expression "the trimming tool" should be "the cutting tool".

Appropriate correction is required.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1-5 and 7 are rejected under 35 U.S.C. 102(b) as being anticipated by Beller, U.S. Patent 4,979,413, as set forth in paragraph 4 of action mailed 10/6/03 and further explained here.

Beller discloses cutting a second portion of the piping material (the excess edge that is removed from the double welt) next to a cutting guide surface (surface of notch 38) parallel to the holding device (40). The notch surface extends parallel to the holding device (40) surface.

As to claim 2, Beller discloses the step of placing a section of piping material containing a fabric and a cording material in the holding device (see column 1, lines 1-30).

As to claim 4, Beller discloses covering a predetermined seam allowance portion with the trimming tool as shown in Figures 1 and 9 by notches 38 and 36.

As to claim 5, Beller discloses placing pressure on the trimming tool during the cutting step by pulling on the welt material.

As to claim 7, Beller discloses the step of leaving a seam allowance of a predetermined width on the material.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Beller. Beller discloses the invention substantially as claimed including a holding device with a rectangular channel, as shown in Figure 1. In the alternative, even if it is argued that channel of Beller is not completely rectangular, it would have been an obvious matter of design choice to a person of ordinary skill in the art at the time the invention was made to use a completely rectangular channel or any form or shaped that was desired or expedient for the channel of Beller depending upon the size and shape of the welt to be placed in the channel because Applicant has not disclosed that the rectangular channel

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provides an advantage, is used for a particular purpose, or solves a stated problem.

One of ordinary skill in the art, furthermore, would have expected Applicant's invention to perform equally well with either the shaped channel taught by Beller or the claimed rectangular channel because both channels perform the same function holding a well during a cutting operation. Therefore, it would have been obvious matter of design choice to modify Beller to obtain the invention as specified in claim 3.

7. Claims 8-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Beller in view of Hanson et al.

Beller discloses the invention substantially as claimed, including for example: a cording channel (40); a cutting guide surface (surface of notch 36); and a cutting tool (34). However, Beller lacks a transparent body. Hanson et al. discloses that it is old and well known in the art to use transparent bodies (plastic) with cutting tools for the purpose of facilitating accurate cutting of the workpiece. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to make the device of Beller out of transparent material in order to facilitate cutting of the workpiece.

As to claims 10-11, the modified device of Beller discloses a three dimensional rectangular body, with top surfaces, long side surfaces, and bottom surfaces, see Figure 1. The modified device of Beller discloses a "rectangular cut-out" channel with an opening on the bottom surface of the body. It should be noted that the term "rectangular" only implies that the channel is shaped like a rectangle. Furthermore, it is noted that the claims do not set forth any orientation of the tool; more specifically, what

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is the bottom surface of the body. Therefore, the modified device of Beller discloses an opening in the bottom surface, the surface closest to the user.

As to claim 12, the cutting guide surface (the surface/walls of notch 36) is a long side surface. Again, it is noted that the claims do not describe any specific orientation for location for the surfaces; only that there is a top surface, a long side surface and a bottom surface. The language of claim 10 is not limited to, e.g., the interpretation that the long side surface is one of the long sides forming the rectangular body.

As to claim 13, the channel is parallel to the guide surfaces as shown in Figure 9.

As to claims 14-18, the modified device of Beller discloses the use of piping material with cording material encased in a cloth fabric with salvage of seam allowance. In the alternative, the phrases "wherein the piping material includes ... the salvage" (claim 14), "wherein the fabric is ... plastic" (claim 15), "wherein the cording material is ... channel" (claim 17), "the cording material ... channel" (claim 18) do not serve to distinguish the claimed invention from the prior art. The phrases are merely intended use not defining any structural limitations of the device. It should be noted that in apparatus claims, the work piece is not given any patentable weight, because it has been held that a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. See MPEP 2114. In this case, e.g., the modified device of Beller is fully capable of being used with a cording material encased in a fabric and the salvage.

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8. Claims 8-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over McCormick in view of Hanson et al.

McCormick discloses the invention substantially as claimed, including for example: a cording channel (the recess in the bottom surface of tool 16); a cutting guide surface (22); and a cutting tool (24). However, McCormick lacks a transparent body. Hanson et al. discloses that it is old and well known in the art to use transparent bodies (plastic) with cutting tools for the purpose of facilitating accurate cutting of the workpiece. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to make the device of Beller out of transparent material in order to facilitate cutting of the workpiece.

It should be noted that the phrase "cording channel" does not imply any specific structure, shape or size. Clearly a cording channel is capable of fitting in the recess provided by McCormick depending upon the size and shape of the workpiece.

As to claim 10, the body of the modified device of McCormick is a three-dimensional rectangular body with a top surface, a long side surface, and a bottom surface.

As to claim 11, the channel is a rectangular cut-out with an opening on the bottom surface. The modified device of McCormick discloses a rectangular cut-out (the recess in the bottom surface of the body) in the bottom surface of the body as shown in Figures 1 and 3.

As to claim 12, the cutting guide surface (22) is a long side surface.

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As to claim 13, the cording channel is parallel to the cutting guide surface as shown in Figures 1 and 3.

As to claims 14-18, the phrases "wherein the piping material includes ... the salvage" (claim 14), "wherein the fabric is ... plastic" (claim 15), "wherein the cording material is ... channel" (claim 17), "the cording material ... channel" (claim 18) do not serve to distinguish the claimed invention from the prior art. The phrases are merely intended use not defining any structural limitations of the device. It should be noted that in apparatus claims, the work piece is not given any patentable weight, because it has been held that a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. See MPEP 2114. In this case, e.g., the modified device of McCormick is fully capable of being used with a cording material encased in a fabric and the salvage.

As to claim 19, the cutting tool is a rotary cutting blade.

As to claim 20, the cutting tool is fully capable of cutting salvage. See above notes about intended use recitations regarding the workpiece.

9. Claims 1-2 and 4-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cornell et al., U.S. Patent 5,996,459, or Daley, Jr., U.S. Patent 6,098,515, in view of Mitchell.

Cornell et al. and Daley both disclose the invention substantially as claimed including the steps of covering a workpiece with a trimming tool (blade carriage) by

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positioning a first portion (the portion under the holding device) of the workpiece in a holding device (between the cutter rail and the workpiece support, the cutter rails hold the workpiece in a stationary position during cutting); cutting a second portion of the workpiece (the portion extending from the holding areas and adjacent the cutting edge) next to a cutting guide surface (the cooperating cutting surfaces, e.g., the side surface against the blades as shown in Figure 5 of Daley, Jr. or 36 in Cornell et al.); and then using the cutting blade to remove a portion of the workpiece.

Cornell et al. and Daley are not for cutting any specific workpiece, such as piping material; however, Mitchell discloses that it is old and well known in the art to cut piping material for the purpose of providing specific length of piping material depending upon the amount needed. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to use the Cornell et al. or Daley devices for cutting piping material in order to obtain specific amounts of piping material.

As to claims 2, 4, and 7, the modified devices of Cornell et al. and Daley disclose covering and removing salvage such that a seam allowance of predetermined width is left (see Mitchell).

As to claim 5, the modified devices of Cornell et al. and Daley disclose the step of cutting includes applying pressure on the trimming tool. In order for the cutters of Cornell et al. and Daley to work a user must apply pressure on the blades to force engagement of the blade and workpiece.

As to claim 6, the modified devices of Cornell et al. and Daley disclose rotary cutting blades (see Figures 1 and 2, respectively).

Response to Arguments

10. Applicant's arguments filed 4/5/04 have been fully considered but they are not persuasive.

Applicant contends that Beller teaches away from the simplicity of the present invention because Beller is much more complex. Although, applicant may be correct, in that, Beller is more complex; however, the only requirement under 35 USC 102 is that the prior art references met every limitation, not that one is more complex over the other. Moreover, the transitional phrase "comprising" is well established as an open-ended phrase, allowing prior art references to encompass more structural elements than claimed. It appears, in the examiner's opinion, that it is not merely a matter of complexity but rather claim interpretation, that is, the claims do not adequately describe applicant's invention. Even if there is some truth to applicant's argument that does not eliminate applicant's requirement to adequately claim the invention. At what point does the patent office just give everyone a patent with broad claims where applicant argues the prior art is more complex regardless of the how the claims read and whether or not the prior art encompasses the claimed subject matter?

Applicant further contends that McCormick is not relevant to the present invention nor is it obvious to one skilled in the art to combine the teachings of Hanson with McCormick. The examiner respectfully disagrees. McCormick is relevant because it discloses all of the same structure as claimed. As stated above, the workpiece does not serve to distinguish the claimed invention from the prior art. Moreover, Hanson is only being relied upon to teach the use of transparent covers with cutting tools. Hanson

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and McCormick may arguably be from different fields of endeavor but Hanson is reasonably pertinent to the particular problem of viewing a workpiece while it is being cut to ensure accurate alignment.

11. For the reasons above, the grounds of rejection are deemed proper.

Conclusion

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

13. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

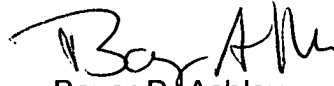
A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Boyer D. Ashley whose telephone number is 703-308-1845. The examiner can normally be reached on Monday-Thursday 7:30-6:00.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Allan N. Shoap can be reached on 703-308-1082. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Boyer D. Ashley
Primary Examiner
Art Unit 3724

BDA
June 23, 2004